

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

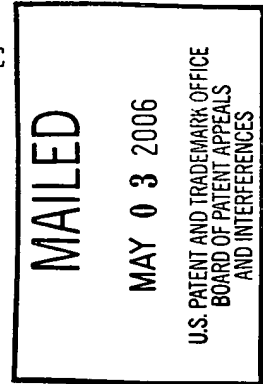
Ex parte FUMITAKE YODO

Application No. 09/923,702

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on April 24, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On February 24, 2005, the USPTO received an Appeal Brief filed by the appellant under the rules set forth in 37 CFR § 1.192(c). However, the rules under 37 CFR §1.192(c) were abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c).



37 CFR § 41.37(c) states:

. . . The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) Real party in interest. A statement identifying by name the real party in interest.

(ii) Related appeals and interferences. A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) Status of claims. A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) Status of amendments. A statement of the status of any amendment filed subsequent to final rejection.

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus

function as permitted by 35 U.S.C. § 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) Grounds of rejection to be reviewed on appeal. A concise statement of each ground of rejection presented for review.

(vii) Argument. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

Application No. 09/923,702

(viii) Claims appendix. An appendix containing a copy of the claims involved in the appeal.

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

. . . .

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

A review of the application reveals that the following sections are improperly labeled in the Appeal Brief:

(1) "Summary of the claimed subject matter" as set forth in 37 CFR § 41.37(c)(1)(v) (replaces "Summary of the Invention").

Application No. 09/923,702

(2) "Grounds of rejection to be reviewed on appeal," as set forth in 37 CFR § 41.37 (c)(1)(vi) (replaces "Issues" and "Grouping of Claims");

The following sections are missing from the Appeal Brief:

(1) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and

(2) "Related proceedings appendix," as set forth in 37 CFR § 41.37 (c)(1)(x).

A substitute brief that is in compliance with 37 CFR § 41.37(c) is required.

Also, the Examiner's Answer mailed on May 16, 2005, does not comply with the headings as set forth in the new rules. See the Manual of Patenting Examining Procedure (MPEP) § 1207.02(A). Correction is required.

Further review of the application file reveals that appellant filed two Information Disclosure Statements (IDS's) on September 6, 2005 and February 11, 2006. It is not clear from the record whether the examiner considered the disclosure statements submitted or whether the examiner notified appellant of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. Clarification is required.

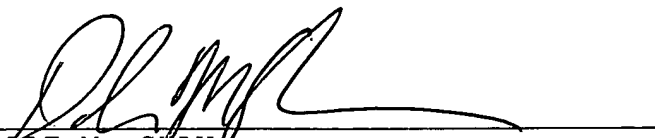
Application No. 09/923,702

Accordingly, it is

ORDERED that the application is returned to the examiner:

- (1) to hold the Appeal Brief received on February 24, 2005 defective;
- (2) to have appellant submit a substitute Appeal Brief in compliance with 37 CFR § 41.37(c) with regard to proper headings and content;
- (3) to vacate the Examiner's Answer mailed on May 16, 2005 and submit a revised Examiner's Answer in compliance with the new rules effective September 13, 2004 pertaining to the proper headings and content;
- (4) to acknowledge the Information Disclosure Statements received by the Office on September 6, 2005 and April 11, 2006;
- (5) to notify appellant of said written consideration of the disclosure statements, have communication scanned into the record; and
- (6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES



DALE M. SHAW
Program and Resource Administrator
(571) 272-9797

Application No. 09/923,702

cc: JAY H. MAIOLI
COOPER & DUNHAM
1185 AVE. OF THE AMERICAS
NEW YORK, NY 10036

DMS/hh